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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 66360/P001D1/10402620	
		Application Number 09/519,151-Conf. #7821	Filed March 6, 2000
		First Named Inventor Manuel Zahariev	
		Art Unit 2154	Examiner L. D. Donaghue

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant /inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)  
is enclosed. (Form PTO/SB/96)

attorney or agent of record.

Registration number 39,643

Craig J Cex  
Signature

Signature

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November 1, 2006

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*

\*Total of 1 forms are submitted.



Docket No.: 66360/P001D1/10402620  
(PATENT)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Manuel Zahariev

Application No.: 09/519,151

Confirmation No.: 7821

Filed: March 6, 2000

Art Unit: 2154

For: MAIL ALERT SYSTEM

Examiner: L. D. Donaghue

### APPELLANT'S ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

### INTRODUCTORY COMMENTS

The Appellant hereby requests that a panel of Examiners formally review the legal and factual basis of the rejections of record prior to the filing of an Appeal Brief. This Request is filed with a Notice of Appeal.

### REASONS FOR REQUESTED PRE-APPEAL REVIEW

#### I. Issues

Claims 1-13 and 15-29 are pending in the present application. Claims 1, 2, 4-6, 8-11, 13, 15-17 and 19-29 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,742,905 issued to Pepe et al. ("Pepe"). Claims 3, 7, 12 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pepe in view of U.S. Patent No. 6,545,589 issued to Fuller et al. ("Fuller"). Applicant respectfully submits that the outstanding claim rejections are improper, and thus requests pre-appeal review of the rejected claims in light of the remarks presented herein.

## II. Rejection under 35 U.S.C. § 103 (Pepe)

Claims 1, 2, 4-6, 8-11, 13, 15-17 and 19-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe. Applicant respectfully submits that this rejection is also improper for the reasons discussed below, and thus requests that the review panel reverse such rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. M.P.E.P. § 2143. Without conceding any other criteria, Applicant respectfully asserts that the rejections do not satisfy the first criteria.

Claims 1 and 5 define an agent adapted to compare characteristics of email messages received for the subscriber to specific message characteristics provided by the subscriber and pre-stored on the server, to alert the subscriber when a characteristic match is found, and to execute instructions received from the subscriber in response to the alert.

The Office Action at page 2 admits that Pepe does not disclose the limitations of claims 1 and 5 regarding email, then alleges the limitations are obvious in view of Pepe through the operation of CallCommand directed to voicemail. Applicant respectfully disagrees with Examiner's modification of Pepe. The mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

It is clear that the CallCommand functionality, which includes the features used by the Examiner, is separate from the email functionality. *See*, column 10, line 34 through column 11, line 32 separately describing email functions and CallCommand functions, or column 14, lines 57-65, showing a table with separate CallCommand (CC) and email systems (options 2 and 3, respectively). Pepe clearly contemplated both email functionality and the CallCommand functions cited by the Examiner but specifically chose (for either technical or design reasons) not to include email in its CallCommand functionality.

Further, Pepe clearly describes email screening at column 34, line 51 through column 35, line 30. Users of Pepe may filter email based on criteria and have matching email forwarded to an email address or notification of the email sent to a designated location. Pepe does not describe executing instructions received from the subscriber in response to an alert as required by claims 1 and 5.

The Examiner argues that Pepe suggest the modification when it states: “wireless technologies make subscribers constantly available, therefore it is important to give them the ability to accept or decline communication attempts at their discretion.” The Examiner continues with a statement in Pepe regarding wireless email: “Sending and receiving email wireless messages involves two types of message flows: sending messages from the PDA 30 to the PCI server 48 and from the PCI server 48 to the PDA 30.” The Examiner cites the portion of Pepe at column 34 described above in support of his contention.

Applicant respectfully asserts that the Examiner’s suggested motivation is merely Pepe’s description of its email screening functionality and not any suggestion to extend the CallCommand functionality to email as suggested by the Examiner. The email screening functionality allows subscribers “to accept or decline communication” as quoted by the Examiner.

Clearly, if Pepe suggested the desirability of the combination, Pepe could have included the email functionality in the CallCommand functions, or suggested the desirability of that functionality in its extensive descriptions of its system. Without such teachings in Pepe, Applicant respectfully asserts that Pepe teaches away from the modification proposed by the Examiner. The Examiner has stated that Pepe does not expressly teach away from the proposed modification. Applicant does not claim otherwise, but merely notes that Pepe’s extensive disclosure describes nearly every unified messaging combination possible, except the one claimed by the Applicant. As such, Applicant asserts that Pepe necessarily teaches away from the modification suggested by the Examiner.

As Pepe was in possession of both the CallCommand functionality, email and email screening technology, both wireline and wireless, yet specifically did not combine the them, nor even suggest the combination in its extensive disclosure, Applicant respectfully asserts that there is no motivation to modify Pepe as suggested by the Examiner. Impermissible

hindsight may not be used in a conclusion of obviousness and as such, knowledge gleaned only from Applicant's disclosure may not be used, see M.P.E.P. 2145, paragraph X.A. and *In re McLaughlin*. As Pepe teaches away from the modification described by the Examiner, the only motivation to make the modification is knowledge gleaned only from the Applicant's disclosure. As there is no proper motivation to modify Pepe as required by the Examiner, claims 1 and 5 are allowable over the rejection of record.

Claim 9 defines a method comprising receiving instructions for forwarding stored messages from a subscriber in response to an alert and forwarding the stored messages for which a match is found to destinations according to the instructions provided in response to the alert. Claim 13 defines an agent comprising a save facility adapted for storing matched messages against future distribution instructions, the future distribution instructions received from a subscriber in response to an alert. Claim 19 defines a method comprising receiving a reply from a subscriber in response to an alert, the reply comprising instructions for a message and processing the message according to the instructions.

With regard to claims 9, 13 and 19, the Examiner proposes the same modification using the same motivation as described with respect to claims 1 and 5. Office Action pages 3, 4 and 5, respectively. As discussed above in the response to the rejections of claims 1 and 5, there is no motivation make modifications to Pepe set forth by the Examiner. Without such motivation claims 9, 13 and 19 are allowable over the rejection of record.

Claims 2, 4, 6, 8, 10-11, 15, 17, and 20-29 each depend directly or indirectly from one of independent claims 1, 5, 9, 13, or 19 and inherit all the features and limitations of their respective base claim. Thus, claims 2, 4, 6, 8, 10-11, 15, 17, and 20-29 each set forth features and limitations not found in Pepe and were improperly rejected, as discussed above. Therefore, Applicant respectfully asserts that for at least the above reasons, claims 2, 4, 6, 8, 10-11, 15, 17, and 20-29 are patentable over Pepe and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

### **III. Rejection under 35 U.S.C. § 103 (Pepe in view of Fuller)**

Claims 3, 7, 12 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe in view of Fuller.

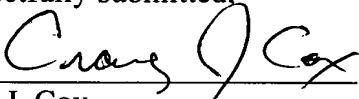
Claims 3, 7, 12, and 18 each depend directly or indirectly from one of independent claims 1, 5, 9, or 13 and inherit all the features and limitations of their respective base claim. Thus, the modification of Pepe required to support the rejections of claims 3, 7, 12, and 18 is improper, as discussed above. Fuller is not relied upon as teaching these limitations. Therefore, Applicant respectfully asserts that for at least the above reasons, claims 3, 7, 12, and 18 are patentable over Pepe in view of Fuller and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

#### IV. Summary

In view of the above, Applicant respectfully requests that the review panel reverse the outstanding rejections in the present application. The required fee for the Notice of Appeal filed with this request is attached. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 66360/P001D1/10402620 from which the undersigned is authorized to draw.

Dated: November 1, 2006

Respectfully submitted,

By   
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